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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,302	09/22/2005	Michihiro Ohnishi	09947.0002-00000	1171

22852 7590 09/20/2010
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EXAMINER

FORMAN, BETTY J

ART UNIT	PAPER NUMBER
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1634

MAIL DATE	DELIVERY MODE
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09/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/550,302

Applicant(s)

OHNISHI ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 September 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,3,4,8-13 and 16-18.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/BJ Forman/
Primary Examiner, Art Unit 1634

Continuation of 11. does NOT place the application in condition for allowance because: The claims have been amended to incorporate the triethylchlorosilane (TECS) of Claim 15 into independent Claim 1. However, Applicant has not provided any evidence that the TECS has any advantages over the surface coating as cited in the prior art. As cited in the Final Office Action, Zenhausern and Quake both teach chlorosilane surface treatments. Quake further teaches a hydrophobic surface treatment. While Quake and Zehnausen do not teach TECS, trimethylchlorosilane (TMCS) was well known in the art (see Wilding). Furthermore, Murphy teaches that both TMCS and TECS provide highly durable and hydrophobic coatings thereby equating TECS and TMCS and providing a reason to use either as an alternative to obtain hydrophobic surface coatings. It is maintained that it would have been obvious to use a functional equivalent to TMCS (of wilding) such as TECS.

While the instant specification teaches that TECS has the advantage of producing a dust-free surface, the specification only compares a TECS surface to octadecyltrichlorosilane. The specification further teaches that the advantage of TECS is based on the single chlorine group. The specification does not compare the claimed TECS to the surface treatments (TMCS) disclosed in the art. Therefore, the specification cannot provide evidence of an advantage over the cited prior art. Applicant is invited to provide any evidence to support the asserted advantage over the prior art.

Regarding the teaching of Wilding and Murphy, Applicant notes that Wilding teaching TMCS, and not TECS as claimed. Applicant argues that one of skill in the relevant art would not look to Murphy because the reference is interested in automobile windows. The argument has been considered. However, all of Zenhausern, Quake, Wilding and Murphy are interested in surface coatings. Therefore, one interested in solving a problem related to surface coatings would look to any teaching of surface coatings and in the instant case, hydrophobic surface coatings. Murphy teaches that TECS and TMCS are functionally equivalent. One of ordinary skill would have been motivated to choose either of the functionally equivalent TECS or TMCS based on availability or costs. Absent evidence to the contrary, it is maintained that the instantly claimed invention would have been an obvious modification of the prior art.